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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/324,511	06/03/1999	HARUHISA SUZUKI	35.G2398	1647

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EXAMINER


O'CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

 Office Action Summary	Application No. 09/324,511	Applicant(s) Suzuki et al.
	Examiner O'Connor	Art Unit 3627

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 28, 2004 (RCE) and June 4, 2004 (Amdt).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 66, 68, and 70 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 66, 68, and 70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 4, 2004 has been entered.

Preliminary Remarks

2. This Office action responds to the amendment to claims 66, 68, and 70 and the arguments filed by applicant on June 4, 2004 in reply to the Office action mailed April 6, 2004.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 66, 68, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al. (US 6,324,521).

Shiota et al. disclose a system and method for providing a plurality of services over a network 5, comprising the steps of: transmitting, by a user 1 terminal 6, a request to a service center 2 for printing an image stored on the network 5; storing, by the service center 2 items and their prices in a first table; storing, by the service center, a plurality of service providers 3, 4, and at least one item included in each type of printing provided by each one of the plurality of service providers 3, 4, in a second table; it being inherent that the stored prices would be updated to reflect new prices as the prices change over time; calculating, by the service center 2, a charge related to the request by referring to the first and second tables; sending a notification from the service center 2 to the user 1 terminal 6, the notification including the charge calculated in the calculating step; forwarding the request from the service center 2 to an appropriate service provider 3, 4, via the network 5 automatically upon receipt by the service center 2 of an instruction from the user 1 terminal 6 based on the calculated charge; and, performing, by the appropriate service provider 3, 4, printing of the image according to the request received from the service center 2. Shiota et al., though, do not specifically disclose that the receipt by the service center of the instruction from the user terminal of whether to print is in *response* to the notification sent to the user terminal of the calculated charge.

However, informing a customer of the price of a product or service, prior to the customer ordering the product or service, such that the customer can place an order in *response* to knowing the price, should the customer find the price acceptable, is certainly a well known, hence, obvious step to perform in any method of selling goods and/or services.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Shiota et al., so as to inform the customer of the price prior to receiving an order from the customer (if Shiota et al. did not already do so), in order to allow the customer to make an informed decision of whether or not to place the order, as is well known to do, since so doing could be performed by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Response to Arguments

5. Applicant's arguments filed June 4, 2004 have been fully considered but are not persuasive.
6. Regarding the argument that Shiota et al. fail to disclose storing items and their prices in a first table, Shiota et al. indeed disclose storing items and their prices in a first table. Without doing so, Shiota et al. would be unable to calculate the correct/appropriate charges because the prices would be unknown.
7. Regarding the argument that Shiota et al. fail to disclose storing a plurality of service providers and at least one item included in each printing type provided by each of the service providers in a second table, Shiota et al. indeed disclose storing a plurality of service providers and at least one item included in each printing type provided by each of the service providers in a second table. Otherwise, Shiota et al. would not know which providers provided which services.

8. Regarding the argument that Shiota et al. fail to disclose updating the prices of the items in the first table, one of ordinary skill in the art would instantly recognize that the method and system of Shiota et al. would necessarily, thus inherently, update the prices of the items stored in the first table in order to reflect new prices as the prices changed over time.

9. Regarding the argument that Shiota et al. fail to disclose calculating a charge related to the request on the basis of referring to the updated first table and the second table, Shiota et al. indeed disclose calculating a charge related to the request on the basis of referring to the updated first table and the second table. The system and method of Shiota et al. clearly calculates the charge, and the charge could not be calculated without referring to the stored prices for the various services.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to the disclosure.

11. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is (703) 305-1525, and whose facsimile number is (703) 746-3976.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is (703) 308-1113.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

September 28, 2004

A handwritten signature in black ink, appearing to read "Gerald J. O'Connor", followed by the date "(9-28-04)" in parentheses.

Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627